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Paper 17

Filed: 18 August 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PASCALE CORPART,
DOMINIQUE CHARMOT, SAMIR Z. ZARD,
THIBAUD BIADATTI, and DANIEL MICHELET,

Junior Party
(Patent 6,153,705)

v.

TAM PHUONG LE,
GRAEME MOAD, EZIO RIZZARDO, and
SAN HOA THANG

Senior Party,
(Application 09/762,833).

Patent Interference No. 105,314

Before Sally Gardner Lane, Administrative Patent Judge.

Redeclaration - Bd.R. 203(c)

Conference calls were held on 27 July 2005 at approximately 2:00 p.m. and 28 July at approximately 10:00 a.m. Participating in the call were:

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BOARD OF PATENT APPEALS
AND INTERFERENCES**

Sally Lane, Administrative Patent Judge,

Gerald Deitch for Le, and

Todd Walters for Corpart

The parties have argued that there are at least two separately patentable inventions included in the genus defined by Count 1, i.e., that subject matter defined by Corpart claim 1 where Z2 is oxygen and Le claim 11 where Z is optionally substituted alkoxy and that subject matter defined by Corpart claim 1 where Z2 is sulfur and Le claim 11 where Z is optionally substituted alkylthio, dialkyl- or diaryl-phosphonato, or dialkyl- or diaryl-phosphinato. Based on discussion during the conference calls, arguments by the parties, and a review of the record, it is appropriate to redeclare the interference by adding Count 2 and Count 3, each of which is directed to patentably distinct subject matter that also is patentably distinct from the genus defined by Count 1. Counts 2 and 3 set forth below are substantially the same as those suggested by the parties as are the claim designations.¹

Upon consideration of the record and for reasons given, it is

ORDERED that the following two counts are added to the interference;

Count 2

Corpart claim 1, wherein Z2 is O

or

Le claim 11 wherein Z is optionally substituted alkoxy.

¹ Despite the parties' suggestion, claim 9 of Corpart is not designated as corresponding to Count 3 since it depends from claim 8 which limits Z2 to oxygen.

Count 3

Corpart claim 1, where Z2 is S

or

Le claim 11 wherein Z is optionally substituted alkylthio, dialkyl- or diaryl-phosphonato, or dialkyl- or diaryl-phosphinato.

FURTHER ORDERED that the following claims are designated as corresponding to Count 2:

Corpart: 1-12, 18-27, and 29

Le: 11-39

FURTHER ORDERED that the following claims are designated as corresponding to Count 3:

Corpart: 1-7, 11, 18, 19, 21-23, 27, and 29

Le: 11-17, 21, 23-25, 27-29, 31-33, and 39

FURTHER ORDERED that each party is accorded the same priority benefit as to the added counts as it was accorded as to Count 1 (Paper 1 at 4 and 5); and

FURTHER ORDERED that all other time periods set in the interference remain in effect.

cc (facsimile):

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